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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/762,342	01/23/2004	Hidehiko Asai	03500.017847.	5188
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EXAMINER DHINGRA, PAWANDEEP				
ART UNIT 2625		PAPER NUMBER		
MAIL DATE 12/12/2008		DELIVERY MODE PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/762,342

Applicant(s)

ASAI, HIDEHIKO

Examiner

PAWANDEEP S. DHINGRA

Art Unit

2625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 September 2008.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12, 13 and 15-21 is/are pending in the application.
4a) Of the above claim(s) 1-11, 14, 22-27 is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 12, 13 and 15-21 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 10/20/2008
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

DETAILED ACTION

- This action is responsive to the following communication: a Response to Restriction Requirement filed on 09/05/2008.
- Claims 12-13, and 15-21 (based on Species III) are now pending, and are being examined on the merits in response to the election made without traverse by the applicant in the present application.

Response to Arguments

Applicant's request for examination of claims of species II in conjunction with claims of elected species III have been fully considered but is not persuasive. Upon further consideration, the examiner still recognizes the present inventions as independent or distinct for the reasons given in the Requirement for Restriction/Election mailed 8/7/2008. The restriction for examination purposes as indicated in earlier correspondence is proper since there is all examination and search burden for the indicated patentably distinct species due to their mutually exclusive characteristics. The species require a different field of search (e.g., searching different classes/subclasses or electronic resources, or employing different search queries); and/or the prior art applicable to one species would not likely be applicable to another species; and/or the species are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph, and therefore would put serious burden on the examiner if restriction is not made.

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 20-21 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 20-21 are drawn to functional descriptive material NOT claimed as residing on a computer readable medium. MPEP 2106.IV.B.1(a) (Functional Descriptive Material) states:

"Data structures not claimed as embodied in a computer-readable medium are descriptive material per se and are not statutory because they are not capable of causing functional change in the computer."

"Such claimed data structures do not define any structural or functional interrelationships between the data structure and other claimed aspects of the invention which permit the data structure's functionality to be realized."

Claims 20-21, while defining a program and storage medium, does not define a "computer-readable medium" and is thus non-statutory for that reasons. A computer program, can range from paper on which the program is written, to a program simply contemplated and memorized by a person. The examiner suggests amending the claims to "a computer readable medium storing a computer executable program" in order to make the claims statutory.

"In contrast, a claimed computer-readable medium encoded with the data structure defines structural and functional interrelationships between the data structure and the computer software and hardware components which permit the data structure's functionality to be realized, and is thus statutory." - MPEP 2106.IV.B.1(a)

Examiner Notes

Examiner cites particular paragraphs, columns and line numbers in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that, in preparing responses, the applicant fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 12-13 and 15-21 are rejected under 35 U.S.C. 103 as being unpatentable over Yoshida Takehiro et al., JP 2002-016812 in view of Suzuki, US 5,289,570.

Re claim 12, Yoshida discloses an image forming apparatus (see abstract) which has an image repeat function (i.e. reprinting) (see abstract; drawings 14-15) capable of performing a layout process (see drawings 14-15) to arrange plural same data (see paragraphs 92-100) in a first direction (vertical direction) on a same face of one recording paper (see drawings 14-15) and also arrange data same as the plural same

data (see paragraphs 92-100) in a second direction (horizontal direction) on the same face of the one recording paper (see drawings 14-15), wherein said image forming apparatus includes a first layout mode that (see drawings 14-15), in the image repeat function (see paragraphs 92-100), the mutually adjacent same data arranged in the first direction on the same face of the one recording paper are arranged in the first direction (see drawings 14-15; paragraphs 92-100), and also the mutually adjacent same data arranged in the second direction on the same face of the one recording paper are arranged in the second direction (see drawings 14-15; paragraphs 92-100), and a layout mode that, in the image repeat function; the mutually adjacent same data arranged in the first direction on the same face of the one recording paper are arranged without intervals (see drawings 14-15, note that there is a boundary/cut line, CL to clarify the separation between the two plural same adjacent images but there is no interval or margin between the two images) in the first direction (see drawings 14-15; paragraphs 92-100), and also the mutually adjacent same data arranged in the second direction on the same face of the one recording paper are arranged without intervals in the second direction (see drawings 14-15; paragraphs 92-100).

Suzuki teaches an image forming apparatus (see figure 2) includes a first layout mode that (see figures 19-22), the mutually adjacent data arranged in the first direction (vertical direction) on the same face of the one recording paper are arranged with intervals added in the first direction (see figures 23-27), and also the mutually adjacent data arranged in the second direction (horizontal direction) on the same face of the one recording paper are arranged with intervals added in the second direction (see figures

23-27), and a second layout mode (see figures 23-27) that, the mutually adjacent data arranged in the first direction (vertical direction) on the same face of the one recording paper are arranged without intervals in the first direction (see figures 19-22), and also the mutually adjacent data arranged in the second direction (horizontal direction) on the same face of the one recording paper are arranged without intervals in the second direction (see figures 19-22), and said image forming apparatus comprises a selector (see figures 2, 5) capable of selecting either one of the first layout mode and the second layout mode (see figures 7, 17, 19-26 with corresponding text) and a controller (see figures 2, 5) for causing to execute the first layout mode in a case where the first layout mode is selected by said selector, and causing to execute the second layout mode in a case where the second layout mode is selected by said selector (see figures 7, 17, 19-26 with corresponding text).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention to modify the image communication device of Yoshida to include the picture image editing system and techniques as taught by Suzuki for the benefit of "forming single-page picture image data in a page memory device by editing a plurality of sets or groups of picture image data input from an input unit, and then furnishing such picture image data edited in a single page format to picture image output equipment" as taught by Suzuki at column 1, lines 5-15.

Re claim 13, Yoshida in view of Suzuki discloses a first setting unit (see Yoshida, figure 1) for setting the number of the same data arranged in the first direction on the

same face of the one recording paper in the image repeat function (see Yoshida, paragraph 97, 100, note that user can print two, three or four same images on one sheet of paper); and a second setting unit (see Yoshida, figure 1) for setting the number of the same data arranged in the second direction on the same face of the one recording paper in the image repeat function (see Yoshida, paragraph 97, 100, note that user can print two, three or four same images on one sheet of paper), wherein, in the case where the first layout mode is selected by said selector (see Suzuki, figures 7, 17, 19-26), said controller causes to perform in the image repeat function (see Yoshida, abstract; drawings 14-15) the layout process to arrange with the intervals added (see Suzuki, figures 23-27) the plural same data which are arranged in the first direction on the same face of the one recording paper and of which the number corresponds to the number of the data set by said first setting unit, in the first direction (see Yoshida, drawings 14-15; paragraphs 92-100) and to arrange with the intervals added (see Suzuki, figures 23-27) the plural same data which are arranged in the second direction on the same face of the one recording paper and of which the number corresponds to the number of the data set by said second setting unit, in the second direction (see Yoshida, drawings 14-15; paragraphs 92-100), and in the case where the second layout mode is selected by said selector (see Suzuki, figures 7, 17, 19-26), said controller causes to perform in the image repeat function the layout process to arrange without intervals the plural same data which are arranged in the first direction on the same face of the one recording paper and of which the number corresponds to the number of the data set by said first setting unit, in the first direction (see Yoshida, drawings 14-15;

paragraphs 92-100; Suzuki, see figures 19-22), and to arrange without intervals the plural same data which are arranged in the second direction on the same face of the one recording paper and of which the number corresponds to the number of the data set by said second setting unit, in the second direction (see Yoshida, drawings 14-15; paragraphs 92-100; Suzuki, see figures 19-22).

Re claims 15-16, claims 15-16 recite identical features, as claims 12-13, except claims 15-16 are method claims. Thus, arguments made for claims 12-13 are applicable for claims 15-16.

Re claim 17, Yoshida in view of Suzuki discloses wherein the layout process in the image repeat function (Yoshida, drawing 14, abstract) can be performed by an image forming apparatus (Yoshida, drawing 1; Suzuki, figure 2) capable of printing either one of image data sent from a scanner (Suzuki, figures 2, 5) and image data sent from a computer (see Yoshida, paragraphs 9, 121-123, note that data can be sent from a PC to another PC and can be printed; Suzuki figures 2, 5 with text), and said selection step enables to select either one of the first layout mode and the second layout mode (see Suzuki, figures 7, 17, 19-26 with text) in the image repeat function (see Yoshida, abstract; drawings 14-15) through an operation unit of the image forming apparatus (see Suzuki, figures 2,5 with text; Yoshida, drawing 1 with text).

Re claim 18, Yoshida in view of Suzuki discloses wherein the layout process in the image repeat function (Yoshida, drawing 14, abstract) can be performed by an image forming apparatus (Yoshida, drawing 1; Suzuki, figure 2) capable of printing

image data sent from a computer (see Yoshida, paragraphs 9, 121-123, note that data can be sent from a PC to another PC and can be printed; Suzuki figures 2, 5 with text), and said selection step enables to select either one of the first layout mode and the second layout mode (see Suzuki, figures 7, 17, 19-26 with text) in the image repeat function through an operation unit of the computer (see Suzuki, figures 2,5 with text; Yoshida, paragraphs 121-123).

Re claim 19, Yoshida in view of Suzuki discloses wherein the layout process (see Suzuki, figures 19-26) in the image repeat function (Yoshida, drawing 14, paragraph 97-100, abstract) can be performed by a computer (see Suzuki, figures 2, 5 with text; Yoshida, paragraphs 9, 121-123, note that processing performed by Facsimile can also be performed by a PC) capable of outputting image data printable by an image forming apparatus (Suzuki, figures 2, 5 with text; Yoshida, paragraph 123), and said selection step enables to select either one of the first layout mode and the second layout mode (see Suzuki, figures 7, 17, 19-26 with text) in the image repeat function through an operation unit of the computer (see Suzuki, figures 2, 5 with text; Yoshida, paragraphs 121-123).

Re claims 20-21, claims 20-21 recite identical features, as claim 15, except claims 20-21 merely deal with executing the method of claim 15 on a computer. Thus, arguments made for claim 15 are applicable for claims 20-21.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to PAWANDEEP S. DHINGRA whose telephone number is (571) 270-1231. The examiner can normally be reached on M-F, 9:30-7:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David K. Moore can be reached on (571) 272-7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/P. D./
Examiner, Art Unit 2625

/David K Moore/

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Supervisory Patent Examiner, Art Unit 2625